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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,612	08/05/2000	Ronald John Rosenberger		2637

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/634,612</b>	Applicant(s) <b>Rosenberger</b>
Examiner <b>James W. Myhre</b>	Art Unit <b>3622</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Aug 26, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-6, 8-15, 17-19, 21-23, 27-29, and 31-59 is/are pending in the application.

4a) Of the above, claim(s) 1-6 and 8-15 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 17-19, 21-23, 27-29, and 31-59 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s). 8  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of Group V (Claims 17-19, 21-23, 27-29, 31, and 33-59) in Paper No. 8 verifying the telephonic election on August 29, 2002 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 33 and 34 recite that the credit card entity either directly or indirectly “provides the cardholders with the opportunity to acknowledge or memorialize what is appropriate”... either on a physical memorial, a website, etc. It is unclear on how the credit card entity is providing the opportunity to the cardholders. An opportunity is not a physical item, but merely an abstract idea of an ability. Webster II, New Riverside University Dictionary defines opportunity as “1. A favorable or promising combination of circumstances. 2. A chance for advancement or improvement.” and gives as synonyms words such as “break, chance, occasion, opening, shot”.

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In view of the other pending claims, the Examiner is interpreting these two claims as meaning that the credit card entity is providing information (messages, advertisements, etc.) to the cardholder on one or more ways for memorializing whatever is desired; and that this information may direct the cardholder to a third entity, such as a website or merchant, which providing memorial services. As such, these two claims are similar in scope to the other claims in the selected group in that the credit card entity is providing information to the cardholder. This interpretation will be used in the consideration of these claims below.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-19, 21-23, 27-29, 31, and 33-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucci (5,655,089).

Claims 17-19, 28, 29, 31, 33, 35-38, 40-42, 45, 47, 49-53, and 55-59: Bucci discloses a method for providing targeted messages/advertisements along with monthly statements (col 3, lines 52-59 and col 4, lines 17-37). These messages may be on a perforated section of the statement or may be on separate forms inserted into the same envelope as the statement (col 4,

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lines 55-65). While Bucci does not explicitly disclose every possible type of message, advertisement, or information which may be included with the statement, such as health reminders, tips, birthday/anniversary reminders, etc., it would have been obvious to one having ordinary skill in the art at the time the invention was made that any desired message or information could be provided with the statement. Indeed, the type of information being included does not change the steps involved in providing this information along with the statement; therefore, the type of information is not pertinent to the patentability of this invention. The Applicant supports this position by the inclusion of Claim 59 which asserts that the information "consists of an 'non-theme' embodiment with a boundless range of subject matters and intended uses that is limited only by the desires of said credit card entity and/or said cardholders."

Claims 34, 39, 46, 48, and 54: Bucci discloses a method for providing targeted messages/Advertisements to cardholders as discussed in the preceding paragraph, and further discloses that the information is provided by a third party (Universal Mail Transmittal Service) associated or linked to the credit card entity (col 2, lines 41-49).

Claims 21-23: Bucci discloses a method for providing targeted messages/Advertisements to cardholders as discussed in the paragraphs above. While it is not explicitly disclosed that the database containing information about the cardholder which is used to target the information includes the cardholder's preferences on when certain types of messages should be delivered, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include cardholder preferences, including scheduling preferences, in the database and to use

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such information when providing targeted messages to the cardholder. One would have been motivated to include such scheduling data in the database in order to provide better targeting of the information so as to increase the cardholder's satisfaction with the system.

Claim 27: Bucci discloses a method for providing targeted messages/advertisements to cardholders as discussed in the paragraphs above. While it is not explicitly disclosed that the credit card entity will provide financial disbursements to cardholders for such things as medical examinations, tests, health insurance, et al., it is old and well known for financial institutions such as banks, credit unions, and other credit entities to pay for health, disability and/or life insurance premiums on their members. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the credit card entity to disburse finances to pay for similar items as claimed. One would have been motivated to pay for these types of items in order to entice new members to join and to provide protection to the credit card entity for monies due in case the member becomes ill, disabled, or dies.

Claims 43 and 44: Bucci discloses a method for providing target messages/advertisements to cardholders as discussed in the paragraphs above. While Bucci does not explicitly disclose that the credit card entity or a third party entity acting in behalf of the credit card entity sets up medical appointments for the cardholder based on information provided by the cardholder, Official Notice is taken that automatic scheduling systems are well known within the art. For example, Goldstein (2001/0021910) discloses a method for providing "scheduling and coordinating pre and post-operative appointments and procedures between patients and medical

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practitioners" (Abstract); Mozayeny et al (2002/0035495) discloses a method for scheduling and coordinating appointments which additionally automatically notifies the patient of delays or cancellation and reschedules the appointment (col 6, paragraph 0066); and Levine (5,093,813) discloses a method for making appointments which notifies the patient of open days, time slots, etc. (Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to not only notify the cardholder of a pending appointment or that it was time for an appointment, but also to include the mechanism to automatically make the appointment for the cardholder in Bucci. One would have been motivated to include the appointment-making mechanism in view of the disclosure in Bucci that the personal information about the cardholder in the database could include medical data.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Byerly et al (6,067,524) discloses a method for providing medical information from third parties to pharmacy customers based on the customer's stored personal preference and demographic data.

B. Katz (2002/0120545) discloses a method for automatically scheduling appointments between buyers and sellers based on each other's availability.

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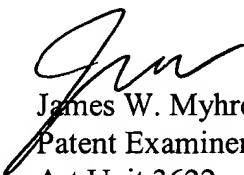
C. Atwood (2002/0103673) discloses a method for pre-screening and scheduling members for medical appointments through a third party entity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM  
January 3, 2003

  
James W. Myhre  
Patent Examiner  
Art Unit 3622